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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,911	10/22/2003	Julie Dawe	10001716-4	6637

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/691,911	Applicant(s) DAWE ET AL.	
	Examiner Houshang Safaipoor	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 13 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Line 4 of claim 13 reciting "means for defining a layout area contained with said means..." is vague. Proper correction is required.

Line 12 of claim 24 reciting "positioning the cover member adjacent a duplicating bed of duplication apparatus so that the arrangement of the at least one object; and" is vague and indefinite. Proper correction is required.

2. Claims 10 and 13 recite the limitation "collage making " in line 3 and 7 respectively.

There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 13-15, 24 and 26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the specified claims of U.S. Patent No. 6, 857,025 (hereinafter refer to as ,025). Although the conflicting claims are not identical, they are not patentably distinct from each other. Explanation is given for each underlined portions of the claims 1, 13-15 and 24 to indicate the obviousness over the specified claims of (,025). Claims of the patent reads on the portions of the claims of the application, not underlined, without any explanation.

Regarding claim 1, claim 1 of (,025) recites apparatus for assisting in the reproduction (production, line 1 of the claim) of an arrangement of at least one object (collage, line 2 of the claim) by duplication apparatus comprising a layout area contained within said apparatus, said layout area accommodating the at least one object, said apparatus being convertible between a layout mode and a duplication mode, said layout area being observable by a user during the layout mode so that the user may observe the arrangement of the at least one object within said layout area, the layout area being reproducible by said duplication apparatus during the duplication mode so that said duplication apparatus produces a copy of the arrangement of the at least one object within said layout area (lines 3-14 of the claim).

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Regarding claim 13, claim 1 of (,025) recites apparatus for assisting in the reproduction (production, line 1 of the claim) of an arrangement of at least one object (collage, line 2 of the claim) by duplication apparatus, comprising:

means for defining a layout area contained with said means, said layout area accommodating the at least one object that is to be contained in the arrangement (collage, line 5 of the claim) said collage making means being convertible between a layout mode and a duplication mode, said layout area being observable by a user during the layout mode so that the user may observe the arrangement of the at least one object within said layout area, the layout area being reproducible by said duplication apparatus during the duplication mode so that said duplication apparatus produces a copy of the arrangement of the at least one object within said layout area (lines 3-14 of the claim).

Regarding claim 14, claim 1 of (,025) recites apparatus for assisting in the reproduction (production, line 1 of the claim) of an arrangement of at least one object (collage, line 2 of the claim) by duplication apparatus, comprising:

a layout area contained within said apparatus, said layout area accommodating the at least one object, said apparatus being convertible between a layout mode and a duplication mode, when in said layout mode, the at least one object being freely moveable by a user within said layout area and said layout area being observable by the user so that the user may observe an arrangement of the at least one object within said layout area (lines 3-10 of the claim);

when in said duplication mode, said layout area being reproducible by said duplication apparatus during the duplication mode so that said duplication apparatus produces a copy of the arrangement of the at least one object within said layout area (lines 11-14 of the claim).

Regarding claim 15, claim 1 of (,025) recites apparatus for assisting in the reproduction (production, line 1 of the claim) of an arrangement of at least one object (collage, line 2 of the claim) by duplication apparatus, comprising:

a backing member (lid, line 15 of the claim), said backing member (lid) defining a layout area (lines 17 and 18 of the claim), said layout area accommodating the at least one object (lines 4 and 5 of the claim); and

a cover member operatively associated with said backing member (lid, line 20 of the claim) so that said cover member can be moved between a first position and a second position, said cover member exposing said layout area when said cover member is in the first position so that the at least one object is freely moveable within said layout area, said cover member securing the at least object contained within said layout area when said cover member is in the second position (lines 19-32 of the claim).

Regarding claim 24, claim 1 of (,025) recites a method, comprising:

providing a backing member (lid) that defines a layout area (lines 15-18 of the claim) and a cover member operatively associated with the backing member (lid) so that the cover member can be moved between at least a first position and a second position, the cover member exposing the layout area of the backing member (lid) when the cover member is in the first position (lines 19-24 of the claim);

positioning at least one object in the layout area of the backing member (lines 4 and 5 of the claim);

moving the cover member to the second position to secure the at least one object in the layout area (lines 25 to 27 of the claim);

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positioning the cover member adjacent a duplicating bed of duplication apparatus so that the arrangement of the at least one object (lines 15-18 and line 31-32 of the claim); and

operating said duplication apparatus to capture an image of the arrangement of the at least one object within said layout area (lines 1-5 of the claim).

Regarding claim 26, claim 1 of (,025) recites a method for making a collage, comprising:

providing a collage making apparatus that defines a layout area (lines 3-4 of the claim);

positioning at least one object within said layout area defined by said collage making apparatus (lines 4-5 of the claim);

observing an arrangement of the at least one object within said layout area (lines 8-10 of the claim);

positioning said collage making apparatus so that said layout area is adjacent a duplicating bed of a duplication apparatus (lines 3-4 of the claim); and

operating said duplication apparatus to duplicate the arrangement of the at least one object within said layout area and to produce a copy of the arrangement of the at least one object within said layout area (lines 9-14 of the claim).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Houshang Safaipoor
Patent Examiner
Art Unit 2625
December 26, 2006

